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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL BISHOP and HONG NGUYEN

Appeal 2009-008209
Application 10/719,476
Technology Center 2600

Before KENNETH W. HAIRSTON, CARLA M. KRIVAK, and
CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 to 25. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

Appellants' invention is concerned with a method (Figs. 2 and 3) and system (Fig. 1) for providing a no-ring telephone call service by routing a telephone call directly to a voice mail service when the called party has a voice mail platform telephone number (Spec.¶ [0001]; Abs.). No-ring call service allows a calling party to leave a message for a called party without causing the called party's telephone to ring, and can be implemented by the calling party who dials a code, such as *21, prior to making a call (Spec. ¶ [0013]). Appellants no-ring call service system and method offer a caller a direct connect option to complete a call by ringing the called party when the called party is found not to have a voice mail platform telephone number that can be found in a region wide database (Abs.; claims 1, 10, 22, and 25).

Claim 1, reproduced below (with emphasis added), is representative of the subject matter on appeal:

1. A method for providing a no-ring telephone call service, the method comprising:

receiving notification that a telephone call from a calling party device requesting to use the no-ring telephone call service has arrived at a switch, the notification including a called party telephone number; and

determining if the called party telephone number corresponds to a voice mail platform telephone number in a region wide messaging database, wherein:

> when the called party telephone number corresponds to a voice mail platform telephone number, instructions to route the telephone call to the voice mail platform telephone number are communicated to the switch;
>
> *when the called party telephone number does not correspond to a voice mail platform telephone number and the calling party device is utilizing the no-ring telephone call service, instructions to play a pre-recorded message are communicated to the switch, the pre-recorded message including a direct connect option for completing the telephone call to the called party telephone number including ringing a device at the called party telephone number*; and
>
> when the calling party device selects the direct connect option, the no-ring telephone call application sends instructions to the switch to complete the telephone call.

(Claim 1 (emphasis added)).

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Medamana	US 5,181,238	Jan. 19, 1993
Kasiviswanathan ("Kasi")	US 6,215,857 B1	Apr. 10, 2001
Shaffer	US 6,600,817 B1	July 29, 2003

The following obviousness rejections are before us for review:

Claims 1 to 5 and 7 to 25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kasi and Shaffer.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Kasi and Shaffer, further in view of Medamana.

In both rejections, the Examiner relies (Ans. 3-5 and 8) upon Kasi as describing the feature common to each of independent claims 1, 10, 22, and 25 of a no-ring telephone call service system, method, and storage medium

having instructions for performing the method that routes a call to a voice mail platform when the called party has a voice mail platform telephone number. The Examiner finds (Ans. 4) that Kasi does not expressly disclose sending a pre-recorded message to a calling party when the called party does not have a voice mail platform telephone number, the message providing a direct connection option that rings the called party's number. The Examiner relies upon Shaffer as teaching this direct connection and ringing option (Ans. 4), and determines that it would have been obvious to provide Shaffer's direct connection option to Kasi's system "to provide an option to abandon or alternatively complete the call to the called party" (Ans. 4), so as to provide a user with another option since no voicemail is available (Ans. 4-5). The Examiner reasons (Ans. 5) that a calling party would prefer to ring the called party to communicate information instead of abandoning the call and not being able to deliver the message; therefore, Shaffer's direct connection feature would be desirable in Kasi's method, system, and storage medium having program instruction for performing the method.

As to both rejections, Appellants contend (Br. 5-8) that Kasi (i) fails to teach a direct connection option to ring a called party, and (ii) teaches away from Shaffer since Kasi teaches against directly connecting a call to a called party and ringing the called party. Specifically, Appellants cite column 2, lines 64 to 67 and column 8, lines 23 to 30 of Kasi as teaching against directly connecting and ringing a call to a called party (Ans. 6-7).

Kasi describes a call routing system and method that enables a calling party to directly connect to the voice mail of the called party

"*without ringing*" the called party (col. 1, ll. 9-15 (emphasis added)). Kasi's main purpose is to provide direct access by the calling party to the voice mail of the called party "*without ringing (disturbing)*" the called party (col. 2, ll. 64-67 (emphasis added)). Kasi's system and method are "particularly useful in business environments where the calling party has the ability to leave a message *without disturbing* the called party" (col. 8, ll. 24-27 (emphasis added)).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). The Examiner's articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

In view of our findings with regard to Kasi *supra*, we find no supportive evidence for the Examiner's assertion (Ans. 4-5) that it would have been obvious to provide Shaffer's direct connection option to Kasi's system "to provide an option to abandon or alternatively complete the call to the called party" (Ans. 4), so as to provide a user with another option when voicemail is not available (Ans. 4-5). Instead, we find Kasi to be limited to the condition that the called party's number corresponds to a voice mail platform telephone number (i.e., a voice mailbox is set up). We also conclude that Kasi teaches away from providing a ringing option when the called party's number does not correspond to a voice mail platform telephone number that exists in a region wide messaging database.

The Examiner's explanation (Ans. 5) that a calling party would prefer to ring the called party to communicate information instead of abandoning the call and not being able to deliver the message is unreasonable since Kasi teaches against ringing the called party's number and disturbing the called party (*see* Kasi at col. 1, ll. 9-15; col. 2, ll. 64-67; col. 8, ll. 24-27).

Based on Kasi's specific disclosure that the called party should not be disturbed and that party's phone should not ring, we find the Examiner's rational for making the suggested modification to the no-ring teachings of Kasi (Ans. 4-5, of providing a user with more options), to be without merit. That is, we agree with Appellants that Kasi teaches away from the Examiner's proposed modification of Kasi with the ringing feature of Shaffer. Accordingly, we will not sustain the obviousness rejection of claims 1 to 5 and 7 to 25 because the Examiner's articulated reasoning in the rejection does not possess a rational underpinning to support the legal conclusion of obviousness. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007).

Because Medamana does not cure the deficiencies of Kasi and Shaffer, we will not sustain the Examiner's obviousness rejection of dependent claim 6 for similar reasons as claim 1 from which it depends.

The decision of the Examiner to reject claims 1 to 25 is reversed.

REVERSED

KIS

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